UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,038	08/27/2001	Shell S. Simpson	10007689-1	5729

7590   02/02/2007

HEWLETT-PACKARD COMPANY
Intellectual Property Adminstration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER
SINGH, SATWANT K

ART UNIT	PAPER NUMBER
2625	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

		Application No.	Applicant(s)
Office Action Summary		09/941,038	SIMPSON ET AL.
		Examiner	Art Unit
		Satwant K. Singh	2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>24 November 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *10-17 and 22-27* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *10-17 and 22-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>27 August 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   This office action is filed in response to the amendment filed on 24 November

2006.

Response to Arguments

2.   Applicant's arguments with respect to claims 10 and 22 have been considered

but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   Claims 10, 13-16, 22, and 24-27 are rejected under 35 U.S.C. 102(e) as being

anticipated by Mazzagatte et al. (US 6,862,583).

5.   Regarding claim 10, Mazzagatte et al disclose a method comprising: receiving, at

a web service representing a printer, a request to print a document (Fig. 5, S503) (print

node receives print data) (col. 8. lines 62-67, col. 9. lines 1-7); receiving, at the web

service, an identification of the user (sender submits print job along with unique

identification information) (col. 8, lines 19-30); automatically detecting when the user is

in close physical proximity to the printer (recipient inserts smart-card) (col. 9, lines 45-

55); and waiting to print the document until the user is in close physical proximity to the printer (upon presenting the smart-card to the smart-card reader, printer verifies unique identification information and proceeds with the printout process) (col. 9, lines 56-62).

6.   Regarding Claim 13, Mazzagatte et al disclose a method, wherein the web service is included in a proxy coupled to the printer (Fig. 4, server 40) (server 40 acts as gateway for other devices on network 100 to another network such as the Internet) (col. 4, lines 31-34).

7.   Regarding Claim 14, Mazzagatte et al disclose a method, wherein waiting to print the document further comprises waiting to print the document until the user has selected a particular one or more buttons on the printer (intended recipient could enter a PIN or a password form a keypad or touch display device located at the printer) (col. 10, lines 1-6).

8.   Regarding Claim 15, Mazzagatte et al disclose a method, wherein waiting to print the document further comprises waiting to print the document until the user has entered a particular personal identification number (PIN) at the printer (intended recipient could enter a PIN or a password form a keypad or touch display device located at the printer) (col. 10, lines 1-6).

9.   Regarding Claim 16, Mazzagatte et al disclose a method, wherein the web service receives the PIN form the same computing device as the request to print the document is received from (Fig. 5, S502) (send node transmits data to print node) (col. 8, lines 43-61).

10. Regarding Claim 22, Mazzagatte et al discloses a system comprising: a network service representing a printer (Fig. 1, printer 50); a client computing device (Fig. 1, desktop computer 10) configured to, execute a network browser via which a content representing a printer can be displayed to allow a user of the client computing device to request a document to be printed at the printer (Fig. 2, network interface 260) (interfacing to network 100) (col. 4, lines 49-60) (sender submits a print job from a sending node, such as a desk top computer) (col. 7, lines 46-56), automatically detect an identity of the user (smart card interface 15) (compute can authenticate the use's identity to the desktop computer) (col. 4, lines 4-12), communicate the print request and identity of the user to the network service (sender submits the print job along with unique identification information) (col. 8, lines 20-30); and wherein the network service is configured to, receive the print request and the identity of the user (data is received by the print node) (col. 8, lines 62-67, col. 9, lines 1-14), automatically detect when the user is in close physical proximity to the printer by identifying the identity of the user being located on a device within the range of a proximity sensor at the network device (intended recipient inserts a smart-card containing the unique information into the smart-card reader) (col. 9, lines 46-55), and waiting to print the requested document until the user has been detected in close physical proximity to the printer (upon presenting the smart-card to the smart-card reader, printer verifies unique identification information and proceeds with the printout process) (col. 9, lines 56-62).

11. Claim 24 is rejected for the same reason as claim 13.

12.   Regarding Claim 25, Mazzagatte et al disclose a system, wherein the content

representing the printer can be displayed to allow a user of the client computing device

to enable a private printing option along with the request for the document to be printed

(select a secure print option) (col. 7, lines 57-67, col. 8, lines 1-20).

13.   Regarding Claim 26, Mazzagatte et al disclose a system, wherein automatically

detecting the identity of the user comprises querying an operating system of the client

computing device for the identity (smart-card contains unique identification information

which is supplied to the computer) (col.8, lines 30-42).

14.   Regarding Claim 27, Mazzagatte et al disclose a system, wherein automatically

detecting the identity of the user comprises using a proximity sensor that is part of the

client computing device to identity the user identification from a device worn by the user

(smart-card 16) (col. 4, lines 4-12).

Claim Rejections - 35 USC § 103

15.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

16.   Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Mazzagatte et al in view of Fergen et al. (US 6,857,568).

17.   Regarding Claim 11, Mazzagatte et al fail to teach a method, wherein

automatically detecting when the user is in close physical proximity to the printer

comprises detecting when the user is within a threshold distance of the printer, wherein

the threshold distance is not greater than a range of a proximity sensor that is a part of the printer.

Fergen et al teach a method, wherein automatically detecting when the user is in close physical proximity to the printer comprises detecting when the user is within a threshold distance of the printer, wherein the threshold distance is not greater than a range of a proximity sensor that is a part of the printer (proximity sensor 38) (col. 6, lines 38-40).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Mazzagatte with the teaching of Fergen to detect if the user is close enough to the printer prior to printing the document.

18.   Claims 12 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzagatte et al in view of Matsubayashi et al. (US 7,073,119).

19.   Regarding Claim 12, Mazzagatte et al fail to teach a method, wherein the web service is embedded in the printer.

Matsubayashi et al teach a method, wherein the web service is embedded in the printer (Fig. 3, embedded web server 32).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Mazzagatte with the teaching of Matsubayashi to use a printers own embedded web server to print private documents over the internet.

20.   Claim 23 is rejected for the same reason as claim 12.

21.   Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Mazzagatte et al in view of Nykanen et al. (US 6,285,889).

22.   Regarding Claim 17, Mazzagatte et al fail to teach a method, wherein the

receiving comprises receiving the identification of the user from a client computing

device being used by the user, and wherein no printer driver for the printer is installed

on the client computing device.

Nykanen et al teach a method, wherein the receiving comprises receiving the

identification of the user from a client computing device being used by the user, and

wherein no printer driver for the printer is installed on the client computing device (no

printer drivers are needed in portable terminal device 10) (col. 5, lines 59-62).

Therefore it would have been obvious to one of ordinary skill in the art at the time

of the invention to have combined the teachings of Mazzagatte with the teaching of to

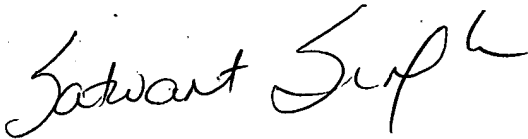allow computing devices without printer drivers to be able to output print jobs.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Satwant K. Singh whose telephone number is (571)

272-7468. The examiner can normally be reached on Monday thru Friday 8am -

4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kimberly A. Williams can be reached on (571) 272-7471. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Satwant K. Singh
Examiner
Art Unit 2625

sks

DAVID MOORE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600